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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/524,160	03/10/2006	Olaf Kersten	3029448 US01	4000
72742	7590	08/05/2010		
Hiscock & Barclay, LLP One Park Place 300 South State Street Syracuse, NY 13202-2078			EXAMINER NICHOLS IL ROBERT K	
			ART UNIT	PAPER NUMBER
			3754	
			MAIL DATE	DELIVERY MODE
			08/05/2010 PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/524,160

**Applicant(s)**

KERSTEN, OLAF

**Examiner**

ROBERT K. NICHOLS II

**Art Unit**

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 February 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 21-37 and 39-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-37 and 39-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

This office action is responsive to the amendment filed on 02/03/2010. As directed by the amendment: claims 21, 36 and 42 have been amended, claim 38 has been cancelled, and no new claims have been added. Thus, claims 21-37 and 39-42 are presently pending in this application.

### ***Claim Objections***

Claim 35 is objected to because of the following informalities: Claim 35 recites "the valve housing" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim. It is suggested to amend to --the valve stem--.

Appropriate correction is required.

Claim 28 is objected to because of the following informalities: Claim 28 recites "the welding seams" in line 2. There is insufficient antecedent basis for this limitation in the claim

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which

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said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 21-37 and 39-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Werding (US 4,969,577) in view of Nikolich (US 5,115,944) and Geier et al. (US 5,630,530).**

Regarding claim 21-29, 31-37, 41 and 42, Werding discloses a discharge valve including a sack 58 of flexible film material, the sack 58 being welded in a border area in two superimposed layers (see col. 7, lines 28-47); a receptacle body 57/59 which is welded in the border area between the two layers of the film material of the sack, the receptacle body 57/59 and the sack 58 being entirely made from a material permeable to organic media (i.e. polyethylene; see figs. 7 and 8, and col. 7, lines 28-47). Werding further discloses the receptacle body 57/59 and a valve stem 56 being connected with each other using a clamp or snap connection (see fig. 8 and col. 7, lines 25-28). Werding discloses all the elements of the claimed invention but is silent to details of the clamp connection between the receptacle body and the valve stem.

Nikolich teaches a discharge valve including a sack 14 of flexible film material and a valve stem 30 that includes a tubular section (fig. 4), a receptacle body 80/84/82 having a tubular appendage 84 having a tubular section with a widened end section, the end section narrows in a truncated shape towards its free end (fig. 4); and the valve stem 30 having a receptacle as a counterpart including a step in its opening section that reduces the diameter (see fig. 4), in order to connect the receptacle body and valve stem with each other using a clamp connection (see figs. 4 and 5). Nikolich discloses the receptacle body

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80/84/82 including a circumferential tapered ring on its side facing the valve stem 30 (tapered circumferential ring of member 84); and a tapered-oval cross section (tapered-oval shape of member 84; see sectional view of figs. 4 and 5), whose tips point to welding seams 64, 66 (see figs. 2, 4 and 5).

Nikolich additionally discloses a flexible BUNA gasket 90 having a shape of a flat ring arranged between the receptacle body and valve stem (see figs. 4 - 6), wherein the gasket 90 at least partially covers the frontal or bearing surface of the receptacle body 80 on its side facing the valve stem 30, wherein the diffusion of organic media is prevented by the gasket and the valve stem (see figure 4 and 5, and column 5 lines 15-21).

Thus, one of ordinary skill in the art would recognize that the known option of providing the device of Werding, with a clamp connection including a gasket as taught by Nikolich, involves only routine skill in the art, for the predictable result of providing a secure connection between the receptacle body and valve stem, and additional sealing means for sealing the bag off completely from the interior of the container.

It is noted the recitation that an element is "able to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense.

With further regards to claims 21-29, 31-37, 41 and 42, the combination of Werding and Nikolich discloses all the elements of the claimed invention except the valve stem being made of a synthetic material that is impermeable to organic media.

Geier teaches a discharge valve including a valve stem 14 which is made of a synthetic material that is resistant to breaking and essentially impermeable to organic media (see col. 5, lines 22-25).

Thus, one of ordinary skill in the art would recognize that the known option of constructing the valve stem of the device of the combination of Werding and Nikolich, of a synthetic material that is impermeable to organic media, as taught by Geier, involves only routine skill in the art, for the predictable result of providing a member resistant to breaking and diffusion of organic media.

Notwithstanding, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have constructed the valve stem of the device of the combination of Werding and Nikolich of a synthetic material that is impermeable to organic media, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Regarding claim 30, the combination of Werding and Nikolich discloses all the elements of the claimed invention except the appendage being formed on the valve stem and the receptacle being provided with the receptacle body.

It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the valve stem with the appendage and the receptacle body with the receptacle, since it has been held that a mere reversal of the essential working parts of a device involves only routine skill in the art. *In re Einstein*, 8 USPQ 167

Regarding claims 39 and 40, and with further regards to claims 21, 28, 32, 34 and 36, it is noted the patentability of a product does not depend on its method of production. If the product in the product-by process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. In re Thorpe, 777 F.2d 695, 698,227 USPQ 964,966 (Fed. Cir. 1985)

### ***Response to Arguments***

Applicant's arguments submitted under "Remarks" in the response filed on 02/03/2010 have been fully considered but are moot in view of the new rejections made in this action.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be

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calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT K. NICHOLS II whose telephone number is (571)270-5312. The examiner can normally be reached on Mon-Friday 9-5. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on 571-272-4720. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. K. N./  
Examiner, Art Unit 3754

/Kevin P. Shaver/  
Supervisory Patent Examiner, Art  
Unit 3754